

REMARKS

The above amendments and these remarks are in reply to the Office action mailed June 15, 2004. Claims 4-39 were added by preliminary amendment dated December 29, 2003. With the addition of Claims 40-56 herewith, Claims 4-56 are pending in the application.

PROVISIONAL DOUBLE PATENTING REJECTION

Claims 4-39 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4-38 of copending Application No. 10/748,482. Applicants file herewith a terminal disclaimer to overcome the double patenting rejection. Should the Examiner decide to withdraw the obviousness rejection in light of the remarks below, he can issue a notice of allowance because any double patenting rejection is overcome by the filing of the terminal disclaimer herewith.

OBVIOUSNESS UNDER 35 U.S.C. § 103

Claims 4-39 stand rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,088,928 to Chan ("Chan") in view of U.S. Patent No. 5,681,170 to Rieber et al. ("Rieber"). Applicants respectfully traverse the rejection as follows.

The present invention discloses and claims an educational toy having a housing that contains the speaker and processor and which supports the work platform required for operation of the toy. More specifically, each of the independent claims recites *inter alia* a toy housing, wherein the toy housing encloses a speaker and a processor, the toy housing further supporting the work platform. The speaker within the housing outputs the questions or

instructions designed to encourage a child to make a cognitive decision and indicate the cognitive decision by causing contact with the work platform. The processor: a) executes educational software, b) receives information from the sensing system corresponding to the occurrence of contact by the child on the work platform and c) uses the information from the sensing system to determine whether the child's cognitive decision as indicated by the establishment of contact by the child on the work platform corresponds to a correct response to the question or instruction.

The Examiner states that, "Chan does not appear to disclose audio questioning." See May 24, 2004 Office Action at ¶ 4. Chan also fails to disclose a toy housing which contains the speaker and processor required for operation of the toy. The Examiner recognized that this aspect of the present invention was also not disclosed by Chan in the May 18, 2004 Office action in the co-pending application 10/748,482 (cited above). The Examiner stated, "the processor and speaker of Chan are external to the touch surface platform. Furthermore, Chan does not appear to disclose audio questioning." See May 18, 2004 Office Action in co-pending application 10/748,482 at ¶ 3. In rejecting the claims in the 10/748,482 application under § 103, the Examiner relied on the combination of "Chan in view of Kono, and further in view of Rieber et al." Id at ¶ 2.

Applicants respectfully submit that there is no suggestion to combine the touch pad based device of Chan with the telephone toy of Rieber. Chan expressly teaches away from this combination, and teaches away from the processor-based largely self-contained toy as recited in the present application. Chan repeatedly discusses the benefits (i.e., low cost and simple to manufacture) of combining a separate touch-sensitive surface with a separate computer.

This invention provides a **low-cost apparatus** with standard game-port interface to commonly known personal computer systems, and enables users, especially children to play computerized programmable education games with finger pointing. The printer matter contains no holes. The touch area is large and thus does not require precision pointing. The touch pad is self-contained with no external interface electronics, and consists of only two layers. There are two additional non-position sensing touch switches for start, reset, clear and/or player A and B move identification. **Thus, it is easy to use, reliable, and inexpensive to manufacture.**

The present invention combines the advantages of both the conventional educational game and those of the computer video game without their inherent disadvantages of using a keyboard, a joystick or a precision pointing touch-sensing apparatus for input by small children. Briefly, a game apparatus according to this invention, includes: a set of printed cards/boards, a novel low-cost touch sensitive pad, an interface cable to the computer game-port, and a computer program corresponding to the said set of printed cards/boards. **Thus, this programmable educational board game apparatus, according to this invention can be produced at a very low cost for the consumer market.**

Another objective of this invention is to provide a low-cost general-purpose boardgame apparatus for one or more players with standard game-port interface to commonly known personal computer systems, and enables users, especially children to play computerized programmable board games with a variety of gameboards and moving-game pieces. . . . Again, the touch pad is self-contained with no external interface electronics, and consists of only two layers. There are two additional non-position sensing touch switches for start, reset, clear and/or player A and B move identification. **Thus, this board game apparatus is fun to use, reliable, versatile and inexpensive.**

. . .

As will become apparent, the computerized educational games and board games apparatus incorporating the invention are, relative to the educational/board games on the market, are much more versatile, **but still inexpensive to manufacture due to the novel construction of the touch pad and its interface to the game-port of the personal computer system.**

It would have been contrary to the low-cost approach of Chan to include a speaker for generating audio prompts and a processor capable of: a) executing educational software, b) receiving information from the one or more sensors corresponding to the occurrence of

contact by the child on the touch-sensitive surface and c) using the information from the sensors to determine whether the child's cognitive decision as indicated by the establishment of contact by the child on the touch-sensitive surface corresponds to a correct response to the question or instruction. One of average skill in the art would clearly have recognized that this would have defeated the design goals of Chan. Thus, the skilled artisan would read Chan to teach away from its combination with Rieber.

The law is clear that, before prior art references can be combined, the Examiner must show some suggestion or motivation found in the art to make the combination. *In re Dance*, 160 F.3d 1339, 1343 (Fed. Cir. 1998). "It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements." *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957 (Fed. Cir. 1997). Nor is the fact that references *can* be combined sufficient to meet this criterion. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). Moreover, the fact that the combination would be well within the ordinary skill in the art, by itself, is insufficient to meet this criterion. *Al-Site Corp. v. VSI Intern., Inc.*, 174 F.3d 1308, 1324 (Fed. Cir. 1999). The examiner needs to show the additional step of how this knowledge of the skilled artisan leads to the suggestion or motivation.

In the instant rejection, in support of the combination of Chan and Rieber, the Examiner has stated merely that, "It would have been obvious to one of ordinary skill in the art that the Chan device use audio questioning as taught by Rieber." The Examiner, however, provides no support for this statement. As indicated above, the law requires more than such unsupported suppositions. Without a clear showing of where the art teaches the combination,

applicants respectfully submit that the combination of Chan and Rieber is improper and respectfully request that the rejection on these grounds be withdrawn.

Even where the cited references are combined, applicants respectfully submit that the combination does not teach or suggest the invention recited in the claims. As set forth hereinafter in the next section, the claims of the present invention have been amended to clarify features of the invention which are nowhere found in the cited references, taken alone or in combination with each other.

AMENDMENTS TO THE CLAIMS

Applicants respectfully submit that the claims as originally filed fully distinguish over the prior art and are patentable thereover. Notwithstanding, Applicants have amended the claims to further clarify the invention relative to the prior art.

All of the added limitations are fully supported by the specification of the application: sensing system capable of sensing and distinguishing between two or more simultaneous child-caused contacts with the work surface (see e.g., FIG. 1, 2, 7 and 8 and page 8, lines 9 – 11); sensing system comprising a grid of wires and wires of the grid are sequentially energized so that contact caused by the child generates a variation in one or more of the wires of the grid from which the location of contact along the work platform can be determined (see e.g., page 14, line 10-22, page 12, lines 7-22); a explorative learning capability wherein the child explores letters, words, numbers or pictures by causing contact with the work platform without there being an incorrect selection of a letter, word, number or picture and when such contact corresponds to a letter, word, number or picture, the toy provides audio feedback corresponding to the letter, word, number or picture (page 20, lines 14-17; page 6, lines 3-

11); a plurality of age-specific educational software wherein different software has been written for the toy for children of different educational levels and ages (page 19, line 18 – page 20, line 9); a movement tracking capability wherein a valid child input to the toy in response to an audio prompt includes the lateral movement of a child-caused contact across the face of the work surface while the contact is maintained with the work platform and the processor detects the path of the contact as it moves laterally across the face of the work platform (page 19, lines 13-15; page 9, lines 10-20).

Touch sensitive surface has been broadened to work platform in the independent claims. The dependent claims narrow the work platform to a touch-sensitive surface in claims 40 and 48-51.

An invention as recited including the above limitations is nowhere disclosed, taught or in any suggested in the prior art, whether taken alone or in combination with each other. It is therefore respectfully requested that the rejection on these grounds be withdrawn.

NEW CLAIMS

Applicants have added new claims 40-56. Each of these claims is dependent on one of claims 4-39 discussed above and patentable for at least the reasons set forth above. No new matter has been added.

Based on the above amendments and remarks, reconsideration of Claims 4-39, and consideration of Claims 40-56, is respectfully requested.

The Examiner's prompt attention to this matter is greatly appreciated. Should further questions remain, the Examiner is invited to contact the undersigned attorney by telephone.

Enclosed is a PETITION FOR EXTENSION OF TIME UNDER 37 C.F.R. § 1.136 for extending the time to respond up to and including today, October 15, 2004.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 501826 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

Date: October 15, 2004

By: 

Brian L. Marcus
Reg. No. 34,511

VIERRA MAGEN MARCUS HARMON & DENIRO LLP
685 Market Street, Suite 540
San Francisco, CA 94105-4206
Telephone: 415-369-9660
Facsimile: 415-369-9665